REMARKS

The following remarks present a complete and timely response to the final Office Action mailed February 25, 2004 (Paper No. 11). Claims 1, 3-10, 12-21, and 27-33 remain pending. Claims 2, 11, and 22-26 were canceled via previous amendments.

Applicants note that the Office Action fails to acknowledge the Office's withdrawal of objections to the Drawings and to the Specification. Accordingly, Applicants assume that Applicants' previously submitted amendments rendered the objections moot.

Applicants further note that the Office Action fails to acknowledge the Office's withdrawal of rejections to claims 1-13 and 18-26 under 35 U.S.C. § 112, second paragraph. Consequently, Applicants assume that Applicants' previously submitted amendments overcame these rejections.

Each objection and rejection presented in the final Office Action mailed February 25, 2004 is discussed in the following remarks.

I. Claim Rejections under 35 U.S.C. § 102 - Claims 1, 4, and 5

A. Statement of the Rejection

Claims 1, 4, and 5 presently stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 5,859,911 to Angelo *et al.*, hereafter *Angelo*.

B. Discussion of the Rejection - Claims 1, 4, and 5

Applicants respectfully traverse the rejection of amended claims 1, 4, and 5 for at least the reason that *Angelo* fails to disclose, teach, or suggest each element and/or method step in the claims. A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See *e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129. (Fed. Cir. 1988.)

Claim 1 recites a boot memory comprising a system loader, a configuration file, and executable files.

The Office's rebuttal to Applicants' argument for the patentability of claim 1 over *Angelo* reflects a fundamental flaw in the application of a proper rejection under 35 U.S.C. 102. In this regard, the Office alleges that Applicants amended claim 1 to add a system loader and thus, Applicants' argument that *Angelo* does not teach directing a

system loader to instruct a microprocessor to load a firmware upgrade patch is moot. Applicants disagree.

A proper rejection under 35 U.S.C. § 102 must include each element and limitation in the claim. Applicants' claim 1 includes "at least one fixed storage device receives and stores a boot memory comprising: a system loader; a configuration file; and executable files configured to write a firmware upgrade to the programmable non-volatile memory." Consequently, *Angelo* must disclose, teach, or suggest these and all other elements of claim 1 to anticipate claim 1. For at least the reason that *Angelo* fails to disclose a boot memory that includes a system loader; a configuration file; and executable files configured to write a firmware upgrade to the programmable non-volatile memory, *Angelo* fails to anticipate Applicants' claim 1.

Because independent claim 1 is allowable, pending dependent claims 4 and 5, which depend directly from claim 1, are also allowable. *See In re Fine*, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598. (Fed. Cir. 1988.). Accordingly, Applicants respectfully request that the rejection of claims 1, 4, and 5 be withdrawn.

II. Claim Rejections under 35 U.S.C. § 103 - Claims 3, 6-10, 12-20, and 27-33
A. Statement of the Rejection

Claims 3, 6-10, 12-17, and 27-32 presently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Angelo* in view of U.S. Patent 6,266,809 to Craig *et al.*, hereafter *Craig*. Claim 33 presently stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Angelo* in view of *Craig* in further view of U.S. Patent 6,324,692 to Fiske, hereafter *Fiske*. Claims 18-20 presently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Craig* in view of *Angelo* in further view of *Fiske*.

B. Discussion of the Rejection - Claims 3, 6-10, 12-17, and 27-32

Applicants traverse the rejection of claims 3, 6-10, 12-17, and 27-32 for at least the reason that the proposed combination of *Angelo* in view of *Craig* is improper.

The Office's rebuttal to Applicants' argument for the patentability of Applicants' rejected claims over proposed combinations of *Angelo* in view of *Craig* and *Craig* in view of *Angelo* reflects a fundamental flaw in the application of a proper rejection under 35 U.S.C. 103. In this regard, the Office alleges that *Craig* does not teach away from

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Applicants' claimed invention because *Craig* does not expressly exclude a fixed disk from being present, nor state that the techniques employed by *Craig* for updating firmware in a diskless networked computer will specifically not work if a fixed disk is included in the system. Applicants disagree.

It is noted that Manual of Patent Examining Procedure (MPEP) § 2145, paragraph X(D), upon which the Office relies, cites a single example (*i.e., In re Grasselli*) of when it is improper to combine references where the references teach away from their combination (*i.e.*, where a reference expressly excludes an element or limitation.) Applicants agree.

However, it is well-established law that a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). See MPEP § 2141.02 which states, "A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. "'A *prima facie* case of obviousness can be rebutted if the applicant ... can show "that the art in any material respect taught away" from the claimed invention.' *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997) (quoting *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ2d 549, 553 (CCPA 1974)). 'A reference may be said to teach away when a person of ordinary skill, upon reading the reference, ... would be led in a direction divergent from the path taken by the applicant.' *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999)." Thus, *Craig* cannot be said to not teach away from an Applicant's invention simply because *Craig* did not include an express exclusion of a fixed drive.

Applicants respectfully submit that *Craig* teaches away from Applicants' claim 1, which recites at least one fixed storage device operatively coupled to the at least one microprocessor, wherein the at least one fixed storage device receives and stores a boot memory. *Craig* apparently describes a system and method for updating firmware in a network computer. A network computer, as defined in *Craig*, is a "diskless computer" because it does not include persistent storage such as a floppy disk, hard disk, or CD-ROM. A network computer, as described in *Craig*, contains a limited amount of volatile storage to temporarily store applications and data while the network computer is running. This volatile storage loses its information when the network computer is turned off.

Craig describes that a limited amount of non-volatile storage may be provided to store a security key and a URL to identify the server with which the network computer works. (See *Craig*, column 2, lines 3-24.) Consequently, one skilled in the art, upon reading *Craig*, would be led away from Applicants' claimed system, which includes "a fixed storage device to receive and store a boot memory."

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See MPEP § 2143.01. The modification or combination of *Craig*, which apparently discloses a method for the secure remote flashing of the BIOS of a diskless computer by adding a fixed disk with a boot memory, would necessarily change the principle of operation of the computer disclosed in *Craig*. Consequently, for this additional reason, the teachings of *Craig* cannot be used in combination with the teachings of *Angelo* to render Applicants' claimed invention *prima facie* obvious.

Applicants' independent claim 9 recites "a fixed storage device containing a boot image having appropriate instruction code suited to transition the respective workstation to an operational mode." Consequently, *Craig* teaches away from Applicants' claim 9 because *Craig* teaches away from the claimed fixed storage device.

Applicants' independent claim 14 recites "new data to be stored and a bootable kernel are stored on a fixed memory device within the workstation in response to the remote input." Consequently, *Craig* teaches away from Applicants' claim 14 because *Craig* teaches away from the claimed fixed memory device within the workstation.

Applicants' independent claim 18 recites "delivering a firmware install patch containing a boot image to a boot disk within a plurality of networked workstations." Consequently, *Craig* teaches away from Applicants' claim 18 because *Craig* teaches away from the claimed "delivering to a boot disk . . . within a plurality of workstations."

Applicants' independent claim 27 recites "at least one fixed storage device operatively coupled to the at least one microprocessor, the storage device containing a firmware patch comprising: a patch memory map comprising an index that identifies the location of: an install application; a second firmware different from the first firmware; and a flash application comprising: a bootable kernel including a system loader interface and reboot logic; a firmware update logic; and a non-volatile memory interface."

Consequently, *Craig* teaches away from Applicants' claim 27 because *Craig* teaches away from the claimed "at least one fixed storage device."

The mere fact that a reference teaches away from the combination with another reference is sufficient to defeat an obviousness claim. *See Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383. Therefore, Applicants respectfully submit that the Office Action has failed to establish a proper motivation or suggestion to combine the teachings of *Angelo* in view of the teachings of *Craig* such as to render obvious Applicants' claims 3, 6-10, 12-17, and 27-32. Accordingly, the rejection of claims 3, 6-10, 12-17, and 27-32 should be withdrawn.

C.   Discussion of the Rejection - Claims 18-20

Applicants traverse the rejection of claims 18-20 for at least the reason that the proposed combination of *Craig* in view of *Angelo* in further view of *Fiske* is improper. As discussed above, *Craig* teaches away from Applicants' independent claims 1, 9, 14, and 18. Accordingly, the Office Action has failed to establish a proper motivation or suggestion to combine the teachings of *Craig* in view of *Angelo* in further view of *Fiske* such as to render obvious Applicants' claims 18-20. Accordingly, the rejection of claims 18-20 should be withdrawn.

D.   Discussion of the Rejection – Claim 33

Applicants traverse the rejection of claim 33 for at least the reason that the proposed combination of *Angelo* in view of *Craig* and further in view of *Fiske* is improper. As discussed above, *Craig* teaches away from Applicants' independent claim 27, from which dependent claim 33 indirectly depends. Accordingly, the Office Action has failed to establish a proper motivation or suggestion to combine the teachings of *Angelo* in view of *Craig* in further view of *Fiske* such as to render obvious Applicants' claim 33. Accordingly, the rejection of claim 33 should be withdrawn.

CONCLUSION

In summary, Applicants' claims 1, 3-10, 12-21, and 27-33 are allowable over the cited art of record and the present application is in condition for allowance. Accordingly, a Notice of Allowance is respectfully solicited. Should the Examiner have any comments regarding the Applicants' response, Applicants request that the Examiner telephone Applicants' undersigned attorney.

Respectfully submitted,

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